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Applicants hereby add new claims 21-35 and cancel claims 16-20. Accordingly, claims 1-15 and 21-35 are pending in the present application.

Claims 1-10 and 12-15 were rejected under 35 U.S.C. §102(e) for anticipation by U.S. Patent No. 5,987,127 to Ikenoue et al. in the parent application. Claim 11 was rejected under 35 U.S.C. §103(a) for obviousness over Ikenoue in the parent application.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to claim 1, teachings in lines 23-32 of col. 10 of Ikenoue are identified in the Office Action dated March 20, 2003 of the original Office Action as disclosing that reference 303 scans the document for additional data and data management section 18 is provided with coded information. Col. 5, lines 49-60 of Ikenoue state that *if the document 103 is an original source, the image data includes only data relating to the document image*. It is further disclosed that *if the document 103 is a hard copy produced from an original source, the hard copy includes additional data added to the images from the previous copying operations as well as the image data of the original document*. Additional data is described at col. 6, lines 5-24. Accordingly, it is clear from the teachings of Ikenoue, the original document only includes image data without the additional data, and the additional data only results from copying operations.

Claim 1 recites providing the document comprising an *original document*, extracting at least some information from the machine-readable code if the machine readable code is present on the original document and providing a *database of information that can be present in the machine-readable code on the original document*, the providing the database of information comprising *providing before the scanning*. It is clear from the teachings of Ikenoue, *only image data is provided on the original document* and additional data comprising information of generation, user, copying apparatus and the like (col. 6, lines 1-5) is only provided *for hard copies produced from the original source*. Ikenoue fails to disclose or suggest *extracting information from the machine-readable code if the machine readable code is present on the original document*. Positively-

recited limitations of claim 1 are not shown nor suggested and claim 1 is allowable.

Ikenoue only provides image data on an original document and clearly states additional data is only provided for hard copies added to the image data of the original document. Accordingly, Ikenoue fails to disclose or suggest providing a database of information that can be present in the machine-readable code on the original document in combination with the claimed comparing. Numerous positively-recited limitations of claim 1 are not shown nor suggested by the prior art and claim 1 is allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 5 recites the information included in the machine-readable code includes *a storage location of a file corresponding to the document*. The identified teachings of Ikenoue in cols. 5 and 7 refer to document type, generation identification, copy timing and identification, book code, book name, page number, copy number, user identification number, use time data, password number, total number of pixels and number of generations. The teachings in col. 12 refer to floppy disk analysis wherein no storage location is necessary inasmuch as the floppy itself includes the image data. Claim 5 is allowable over the prior art.

Referring to independent claim 6, teachings in col. 5, lines 48-53 are identified as disclosing the claimed generating. However, Applicants refer the Examiner to the teachings in the same column at lines 54-60 wherein it is stated original documents only include image data and additional data is only added to images from previous copying operations. The identified teachings fail to disclose or suggest *generating the primary image on the document with either a printer or a first copying machine in combination with printing the machine-readable code on the document as it is generated*. Ikenoue is devoid of any printing of additional data on a document as it is generated, but rather the additional data is only provided on hard copies of documents long after they have been generated. Accordingly, Ikenoue fails to disclose or suggest printing

machine-readable code on the document as it is generated and claim 6 is allowable for at least this reason.

The teachings in col. 20, lines 45-62 of Ikenoue are identified as allegedly disclosing the claimed printing. The identified teachings merely refer to operations of the management unit 200 including reception of additional data processed by the image processors 100, 101. The operations of processors 100, 101 refer to operations long after document generation and refer to copying operations of previously-generated documents. The disclosed management unit 200 does not provide any *printing of a machine-readable code on the document as it is generated* as claimed. Printer 202 of unit 200 only provides results of copy management as set forth in col. 20, line 58 and fails to disclose or suggest the claimed *printing the machine-readable code on the document comprising a primary image as it is generated* as positively-claimed in claim 6. Claim 6 is allowable for at least this additional reason.

Ikenoue also fails to disclose or suggest the claimed recording of information printed in the machine-readable code on the document as it is generated, the information being recorded in a database. The teachings of unit 200 in lines 45-62 of col. 20 refer to receiving additional data on the hard copies processed by the image processors 100, 101. The operations of image processors 100, 101 refer to information of copying operations with respect to previously generated documents and fail to teach or suggest recording in a database of information printed in machine-readable code on the document as it is generated as positively-recited in claim 6. Numerous limitations of claim 6 are not shown nor suggested by the prior art and claim 6 is allowable for at least these numerous reasons.

The claims which depend from independent claim 6 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 11, it is stated on page 7 of the Office Action that is well known to use ink that is only visible under certain wavelengths of light in support of the obviousness rejection of claim 11. The undersigned hereby traverses and seasonably challenges such assertion pursuant to MPEP §2144.03

(8th ed.), and requests the Examiner cite a reference in support of his or her position. Applicant believes reasonable doubt exists regarding the Examiner's assertion of judicial notice.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. *See In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. Pursuant to MPEP §2144.03 (8th ed.), Applicant hereby demands evidence with respect to what the Examiner apparently relies upon as being "well-known."

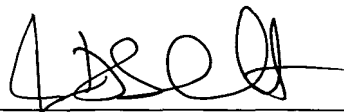
Support for the new claims and amendments may be found at least at pages 3-4 and 6-8 of the specification, Figs. 1-2, and claim 16 of the originally filed application.

New claims 21, 29, and 34 correspond to statements on page 7 of the Office Action. New claims 21, 29, and 34 are allowable over the art.

Applicants request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Paul Jeran et al.

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